

**REMARKS**

By this response, Applicants have added new claims 43 and 44. As a result, claims 21-28 and 31-44 are pending in this application. Reconsideration in view of the following remarks is respectfully requested.

In the Office Action, the Office rejects claims 21, 27-28 and 36-42 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,600,569 (Osada) and U.S. Patent No. 6,314,408 (Salas). In order to establish a *prima facie* case of obviousness, the Office must show that (1) every feature is taught or suggested by Salas and/or Osada; (2) Salas, Osada, or generally available knowledge suggests or motivates the modification(s); and (3) one would have a reasonable expectation of success. MPEP 2143. Because the Office fails to establish a *prima facie* case of obviousness, Applicants respectfully request withdrawal of the rejections of claims 21, 27-28 and 36-42 as allegedly being unpatentable over Osada and Salas.

Initially, the Office fails to show any proper motivation in Salas, Osada or the generally available knowledge for the proposed combination. As the Federal Circuit discussed extensively in *In re Lee*, 277 F.3d 1338; 61 U.S.P.Q.2D 1430 (Fed. Cir. 2002), “[w]hen patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.” Citing *In re Dance*, 160 F.3d 1339, 1343, 48 U.S.P.Q.2D 1635, 1637 (Fed. Cir. 1998), the *Lee* Court goes on to state that “there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant”. *Id.*

The need to show the motivation with specificity has long been recognized by the courts. *Id.* For example, the *Lee* Court cites *In re Kotzab* for the legal requirement that “particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”. *Id.*; *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2D 1313, 1317 (Fed. Cir. 2000). Further, the *Lee* Court cites *In re Rouffet* for the legal requirement that a proper showing of motivation, “even when the level of skill in the art is high, ... must identify specifically the principle, known to one of ordinary skill, that suggests the claimed invention.” *Id.*; *In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q.2D 1453, 1459 (Fed. Cir. 1998).

In the Office Action, the Office states that it would be obvious to one of ordinary skill in the art to share “printing options” in addition to editing and viewing functions allegedly shared in Salas. (Page 4 of current Office Action). However, the Office fails to provide any support for this conclusion in Salas, Osada, or the generally available knowledge. Applicants submit that such a conclusion improperly relies on the hindsight of Applicants’ claimed invention. Under *In re Lee* and the related decisions, such a conclusory statement clearly fails to provide the necessary specificity to show the required teaching, suggestion or motivation for the combination proposed by the Office. In particular, a desired result (i.e., sharing of printing options) does not constitute a specific finding or principle that supports the Office’s selection and/or combination of the components from Salas or Osada to obtain the desired result. To this extent, the Office has failed to show a proper motivation for the specific combination used by the Office.

Further, the Office’s conclusion comprises Official Notice taken by the Office. Applicants submit that such a conclusion is not properly based on common knowledge. For

example, Applicants submit that providing system software for use on a client, which includes both a print driver for generating a print file in response to a print request and an upload manager that automatically transfers the print file over a network in response to the print request using at least one of the HyperText Transport Protocol (HTTP) or the HyperText Transport Protocol Secure (HTTPS) is not obvious to one skilled in the art as alleged by the Office. As a result, Applicants respectfully request that the Office provide support for its conclusion with references that show these features.

The Office also states that “remote users could view and print the file directly without having a local print driver.” (Page 4 of current Office Action). Applicants note that the claimed invention includes providing a print driver for use on a client. As a result, such a motivation clearly teaches away from the claimed invention.

In order to further prosecution of the Application on the merits, Applicants submit that the Office may have intended to state that “remote users could view and print the file directly without having a local [printer].” Assuming, *arguendo*, this is the case, the Office again fails to provide any support for the desirability of this result (i.e., viewing and printing without a local printer) in Salas, Osada, or the generally available knowledge. To this extent, Applicants submit that such a conclusion again improperly relies on the hindsight of Applicants’ claimed invention.

Further, the Office’s assumed statement is directly contradicted by the portion of Osada the Office cites in support of its rejection. In particular, FIG. 15 of Osada shows a computer 109 connected to a printing apparatus 110. Col. 10, lines 37-42. The connection is made, for example, using a local interface defined by the IEEE 1284 standard. Col. 10, lines 43-47. This standard defines communications over a parallel port, which are typically performed at cable

lengths less than thirty-two feet. See, e.g., [www.techweb.com/encyclopedia/](http://www.techweb.com/encyclopedia/); [www.answers.com/topic/ieee-1284](http://www.answers.com/topic/ieee-1284); [www.fapo.com/1284cabl.htm](http://www.fapo.com/1284cabl.htm). Applicants respectfully submit that a cable length of thirty-two feet or less clearly teaches a local printer.

Additionally, the Office takes Official Notice in alleging that “in order to control the upload of the information at the client side, an upload manager such as the interface of Osada would have been beneficial, if not inherent to the client of Salas.” The Office apparently states that the IEEE 1284 standard local interface described in Osada would be inherently used in the communications of Salas. Applicants strenuously disagree with this assertion. In particular, Salas requires the use of HTTP in its communications (see, e.g., Salas, col. 2, lines 39-42). HTTP is commonly used to transfer data over public and private networks. These networks are typically implemented using some combination of serial, ethernet, and/or the like communications links. In sharp contrast, the IEEE 1284 standard comprises a parallel communications standard, which is typically used in one-to-one communications between a computer and another device, commonly a printer. To this extent, the Office’s conclusion is not properly based on common knowledge. As a result, Applicants respectfully request that the Office provide support for its conclusion with references that show these features.

In light of the reasons stated above, either alone or in combination, the Office has failed to show a proper motivation for the specific combination used by the Office. As a result, Applicants respectfully request withdrawal of the rejections of claims 21, 27-28 and 36-42 as allegedly being unpatentable over Osada and Salas.

With further respect to claims 21, 27, 36-37, 39, and 41-42, even if, *arguendo*, the combination is proper, Applicants respectfully submit that the Office has failed to show that the

combination teaches each and every feature of the claimed invention. For example, in claim 21, neither Osada or Salas teaches, *inter alia*, the claimed providing system software for use on a client, wherein the system software includes: a print driver for generating the print file based on a document in response to a print request received from an application; and an upload manager that automatically transfers the print file over the network in response to the print request using at least one of the HyperText Transport Protocol (HTTP) or the HyperText Transport Protocol Secure (HTTPS). In fact, the Office does not allege that any portion of either Osada or Salas teaches the claimed providing system software. Claims 36 and 39 include similar features, and claims 27, 37 and 41-42 depend from either claim 21 or claim 36. As a result, Applicants again respectfully request withdrawal of the rejections of claims 21, 27, 36-37, 39, and 41-42 as allegedly being unpatentable over Osada and Salas.

With respect to newly added claim 43, Applicants note that the claimed invention includes a web server that receives the print file and the network comprises the Internet. A web server is substantially different than a printer in general, and especially the printer in Osada (used by the Office as allegedly disclosing the claimed server). For example, as discussed above, the printer in Osada comprises a local printer, whereas a web server comprises a computer that delivers web pages. Further, the network, rather than being a local connection as in Osada, comprises the Internet. Even if, *arguendo*, Salas teaches communicating data with a web server, neither Salas or Osada teaches or suggests any type of desirability for a web server to receive a print file provided over the Internet.

With further respect to claims 28, 38, and 40, even if, *arguendo*, the combination is proper, Applicants respectfully submit that the Office has failed to show that the combination

teaches each and every feature of the claimed invention. For example, in claim 28, neither Osada or Salas teaches or suggests, *inter alia*, the claimed automatically transferring a print file over a network in response to a print request using at least one of the HyperText Transport Protocol (HTTP) or the HyperText Transport Protocol Secure (HTTPS).

Clearly, Salas fails to teach or suggest transferring any data, let alone a print file, over a network in response to a print request. Similarly, Osada clearly fails to teach or suggest transferring a print file over a network using at least one of HTTP or HTTPS. Additionally, the Office acknowledges that Salas fails to teach or suggest transferring a print file that is generated by a print driver in response to the print request. As a result, the combination of Osada and Salas fails to teach or suggest the claimed automatically transferring a print file, which was generated by a print driver in response to a print request, over a network using at least one of HTTP or HTTPS. In particular, neither reference includes any teaching or suggestion that the automatic transfer of a print file over a network in response to a print request using HTTP and/or HTTPS would be beneficial or desirable.

Claims 38 and 40 include similar features as discussed with reference to claim 28. As a result, Applicants again respectfully request withdrawal of the rejections of claims 28, 38, and 40 as allegedly being unpatentable over Osada and Salas.

Further, the Office rejects claims 22-26 and 31-35 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Salas and Osada and further in view of Tech-Pro TCP/IP Basics, [http://www.tech-pro.net/intro\\_tcp.html](http://www.tech-pro.net/intro_tcp.html) (Tech-Pro). With respect to claims 22-26, Applicants note that the Office relies on its interpretation of Salas and Osada with respect to its rejection of claim 21, from which these claims depend. To this extent, Applicants hereby incorporate the

arguments presented above with respect to the rejection of claim 21. As a result, Applicants respectfully request withdrawal of the rejection of claims 22-26 as allegedly being unpatentable over Salas in view of Osada and further in view of Tech-Pro.

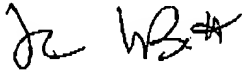
With respect to claims 31-35, Applicants note that the Office relies on its interpretation of Salas and Osada with respect to its rejection of claim 28, from which these claims depend. To this extent, Applicants hereby incorporate the arguments presented above with respect to the rejection of claim 28. As a result, Applicants respectfully request withdrawal of the rejection of claims 31-35 as allegedly being unpatentable over Salas in view of Osada and further in view of Tech-Pro.

Applicants submit that each of the pending claims is patentable for one or more additional unique features. To this extent, Applicants do not acquiesce to the Office's interpretation of the claimed subject matter or the references used in rejecting the claimed subject matter.

Additionally, Applicants do not acquiesce to the Office's combinations and modifications of the various references or the motives cited for such combinations and modifications. These features and the appropriateness of the Office's combinations and modifications have not been separately addressed herein for brevity. However, Applicants reserve the right to present such arguments in a later response should one be necessary.

In light of the above, Applicants respectfully submit that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the number listed below.

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